

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:	Lester Ludwig, et al.	Confirmation No.:	6289
Serial No.:	10/721,905	Art Unit:	2153
Filed:	November 26, 2003	Examiner:	Strange, Aaron N.
For:	<i>METHOD FOR REAL-TIME COMMUNICATION BETWEEN PLURAL USERS</i>	Attorney Docket No.:	063330-5011-US

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

In accordance with the duty of disclosure provisions of 37 C.F.R. §1.56, hereby provided is information in compliance with 37 C.F.R. 1.97 and 1.98 that the Examiner may consider material to the examination of the subject U.S. patent application. The Examiner is requested to make this information of record.

This Information Disclosure Statement is not in support of the petition for accelerated examination submitted in the subject patent application.

1. Enclosures accompanying this Information Disclosure Statement are:

- 1a. ☒ A list of all patents, publications, applications, or other information submitted for consideration by the office.
- 1b. A legible copy of:
 - ☐ Certain U.S. patent application publication and U.S. and foreign patent listed on the PTO-1449;
 - ☒ Certain publications or portions thereof listed on the PTO-1449;
 - ☐ For each cited pending U.S. application, the application specification including the claims, and any drawing of the application, or portion of the application which caused it to be listed on the PTO-1449 including any claims directed to that portion;
 - ☐ All other information or portion which caused it to be listed on the PTO-1449.

- 1c. ☐ An English language copy of search report(s) from a counterpart foreign application or PCT International Search Report.
- 1d. ☐ Explanations of relevancy or English language abstracts of the non-English language publications.
- 1e. ☒ Explanations of relevancy (ATTACHMENT 1(e(i)-(iii), hereto) of the listed requests for *Ex Parte* Reexamination.
2. ☒ This Information Disclosure Statement is filed under 37 C.F.R. §1.97(b):
- ☐ Within three months of the filing date of a national application other than a continued prosecution application under §1.53(d);
- ☐ Within three months of the date of entry of the national stage as set forth in §1.491 in an international application;
- ☐ Before the mailing of the first Office action on the merits;
- ☒ Before the mailing of a first Office action after the filing of a request for continued examination under §1.114.
3. ☐ This Information Disclosure Statement is filed under 37 C.F.R. §1.97(c) after the period specified in 37 C.F.R. §1.97(b), but before the mailing date of any of a final action under 37 C.F.R. §1.113, a notice of allowance under 37 C.F.R. §1.311 or an action that otherwise closes prosecution in the application.

(Check either Item 3a or 3b)

- 3a. ☐ The Certification Statement in Item 5 below is applicable. Accordingly, no fee is required.
- 3b. ☐ The \$180.00 fee set forth in 37 C.F.R. §1.17(p) in accordance with 37 C.F.R. §1.97(c) is:
- ☐ Enclosed
- ☐ To be charged to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310 (order no.).
- (Item 3b to be checked if any reference known for more than 3 months)*
4. ☐ This Information Disclosure Statement is filed under 37 C.F.R. §1.97(d) after the period specified in 37 C.F.R. §1.97(c), but on or before the date of payment of the issue fee.

(Check either Item 4a or 4b)

- 4a. ☐ The Certification Statement in Item 5 below is applicable.
- 4b. ☐ The \$180.00 fee set forth in 37 C.F.R. §1.17(p) is:
- ☐ Enclosed.
- ☐ To be charged to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310 (order no.).
5. ☐ Certification Statement (applicable if Item 3a or Item 4a is checked).

(Check either Item 5a, 5b or 5c)

- 5a. ☐ In accordance with 37 C.F.R. §1.97(e)(1), it is certified that each item of information contained in this Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement.
- 5b. ☐ In accordance with 37 C.F.R. §1.97(e)(2), it is certified that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement.
- 5c. ☐ Pursuant to 37 C.F.R. §1.704(d), each item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart application, and the communication was not **received** by any individual designated in 37 C.F.R. §1.56(c) more than thirty days prior to the filing of this information disclosure statement.
6. ☒ Copies of each cited U.S. patent and each U.S. patent application publication are not enclosed pursuant to the USPTO OG Notice dated 05 August 2003 waiving the requirement under 37 C.F.R. 1.98(a)(2)(i) for U.S. patent applications filed after June 30, 2003.
7. ☐ This application is a continuation application under 37 C.F.R. §1.53(b) or (d).

(Check appropriate Items 7a, 7b and/or 7c)

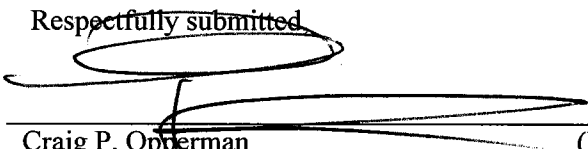
- 7a. ☐ A Petition to Withdraw from issue under 37 C.F.R. §1.313(b)(5) is concurrently filed herewith.
- 7b. ☐ Copies of publications listed on Form PTO-1449 in prior application Serial No. _____ filed on _____, or in any other prior filed patent and/or application from which this application claims priority under 35 U.S.C. §120, are not being submitted pursuant to 37 C.F.R. §1.98(d). The publications listed on Form PTO-1449 that are NOT being submitted herewith are indicated with an "X" in the Form PTO-1499's column headed "Prev. Sub."
- 7c. ☐ Copies of the publications listed on Form PTO-1449 that were not previously cited in prior application Serial No. No. _____ filed on _____, or in any other prior filed patents and applications from which this application claims priority under 35 U.S.C. §120 are provided herewith.
8. ☒ This is a Supplemental Information Disclosure Statement. (Check Item 8a).
- 8a. ☒ This Supplemental Information Disclosure Statement under 37 C.F.R. §1.97(f) supplements the Information Disclosure Statement filed on January 10, 2008.
9. ☐ In accordance with 37 C.F.R. §1.98, a concise explanation of what is presently understood to be the relevance of each non-English language publication is:

(Check Item 9a, 9b, or 9c)

- 9a. ☐ satisfied because all non-English language publications were cited on the enclosed English language copy of the PCT International Search Report or the search report from a counterpart foreign application indicating the degree of relevance found by the foreign office.
- 9b. ☐ set forth in the application.
- 9c. ☐ enclosed as an attachment hereto.
10. ☒ The Commissioner has been authorized through the electronic filing system to charge any additional fees or credit any overpayment for this Information Disclosure Statement to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310 (order no. 063330-5011-US).
11. ☒ No admission is made that the information cited in this Statement is, or is considered to be, material to patentability nor a representation that a search has been made (other than a search report of a foreign counterpart application or PCT International Search Report if submitted herewith). 37 C.F.R. §§1.97(g) and (h).

Respectfully submitted

Date: April 11, 2008


Craig P. Opperman
MORGAN, LEWIS & BOCKIUS LLP
2 Palo Alto Square
3000 El Camino Real, Suite 700
Palo Alto, CA 94306
(650) 843-4000

37,078
(Reg. No.)

ATTACHMENT 1(e)(i)

Relevancy of the Requests for *Ex Parte* Reexamination of U.S. Patent No. 7,185,054

An anonymous third-party Requestor filed a first Request for Reexamination on February 1, 2008 and a second Request for Reexamination (together, “the requests”) on February 22, 2008 requesting reexamination of U.S. Patent No. 7,185,054. Applicants are providing these Requests for the Examiner’s consideration.

Applicants respectfully submit that the Requests for Reexamination and the references cited therein are not relevant for at least the following reasons:

A. The Requests fail to demonstrate where many of the claim limitations are taught by the cited references. For example, and at a minimum, the Requests have not shown where the Rapport references teach:

1. “a graphical rolodex ... including a scrollable listing of entries;”
2. “a quick dial list, listing icons representing video-enabled potential participants;” and
3. “a quick dial list, listing icons ... copied from the graphical rolodex.”

B. The ‘054 patent was allowed over prior art that is far more relevant to the claims of the ‘054 patent than the references relied upon in the Requests for Reexamination.

A. The Requests fail to demonstrate where many of the claim limitations are taught by the cited references.

The Reexamination requests rely primarily on a combination of articles (referred herein as the “Rapport references”). These include: (i) Ahuja et al.: *The Rapport Multimedia Conferencing System*, 1988 (hereinafter “Ahuja ‘88”), (ii) Ahuja et al.: *A Comparison of Application Sharing Mechanisms in Real-Time Desktop Conferencing Systems*, 1990 (hereinafter “Ahuja ‘90”), and (iii) Ensor et al.: *The Rapport Multimedia Communication System (Demonstration)*, May 1992 (hereinafter “Ensor”).

The Requests for Reexamination incorrectly characterize the relied upon Rapport references and fail to show where these references teach many of the claim limitations.

1. The Reexamination requests do not show where the Rapport references teach “a graphical rolodex ... including a scrollable listing of entries,” as required by both independent claims 1 and 10.

The Reexamination requests allege that the Rapport references teach a “graphical rolodex displayed on a participant’s video display device and including a scrollable listing of entries.”¹ For instance, the requests point to Figure 1 on page 240 of Ahuja ’90 and claims that this figure “[I]llustrates a screen-based telephone display having a[n] DIRECTORY button and provides a scrollable listing of video in enabled potential participants.”²

To the contrary, a simple observation of Figure 1 of Ahuja ’90 shows that it does not teach a scrollable directory. Indeed, the supporting description discloses exactly the opposite. Rapport’s call control operations are “based on those of a conventional telephone....”³ Conventional telephones did not offer a scrollable directory in 1990. The Ensor reference confirms this, for example, when it states that “meetings are initiated by dialing a person’s telephone number or specifying the name of a person to be called.”⁴

Accordingly, the Reexamination requests’ assertions that the references teach this claim limitation of independent claims 1 and 10 are entirely incorrect.

2. The Reexamination requests do not show where the Rapport references teach “a quick dial list ... listing icons representing video-enabled potential participants,” as required by both independent claims 1 and 10.

The Reexamination requests allege that Figure 1 of Ahuja ’90 also shows the claimed “quick dial list listing icons representing... potential participants,” because it shows images of participants at the top of Figure 1.⁵

¹ *Ex Parte* Reexamination Request of U.S. Patent No. 7,185,054, filed February 22, 2008, p. 7, lines 17-19.

² *Ex Parte* Reexamination Request of U.S. Patent No. 7,185,054, filed February 22, 2008, p. 7, lines 17-19.

³ Ahuja ’90, p. 241, section 3.

⁴ Ensor, page 581.

⁵ *Ex Parte* Reexamination Request of U.S. Patent No. 7,185,054, filed February 22, 2008, p. 16, lines 12-16.

But, in contrast to showing potential participants, Figure 1 shows seven icons of people who are actual participants already on a call. The seven icons shown in Figure 1 are not part of a list of people that can be selected to establish a call. The people represented by the seven icons are actual participants, and not potential participants. This is further evident when Ahuja '90 states that "three of the eight conferees *are using* their telepointers to note items on the white board."⁶ (Emphasis Added). The "eight conferees" are the seven icons plus a blank, icon-less rectangle at left. Thus, the seven icons represent conferees, not a quick dial list from which participants can be selected to be called.

Accordingly, the Reexamination requests' assertions that the references teach this claim limitation of independent claims 1 and 10 are entirely incorrect.

3. The Reexamination requests do not show where the Rapport references teach "a quick dial list ... listing icons ... copied from the graphical rolodex," as required by both independent claims 1 and 10.

The Reexamination requests have completely neglected to point to any teaching in any of the Rapport references that the quick dial list is "copied from" the graphical rolodex, as required by the claims 1 and 10.

Thus, the Reexamination requests have not shown where the Rapport references teach "a quick dial list ... listing icons ... copied from the graphical rolodex," as required by both independent claims 1 and 10.

B. The '054 patent was allowed over Rapport related prior art that is far more relevant to the claims of the '054 patent than the Rapport references.

The '054 patent was issued over far more relevant prior art. Amongst this prior art are the following references that give far greater detail on the Rapport system, and were cited in an IDS filed on November 1, 2000, and considered by the Examiner on February 21, 2002:

- U.S. Patent No. 5,471,318, issued November 1995 to Ahuja et al., filed April 22, 1993.
- U.S. Patent No. 5,689,553 November 1997, issued to Ahuja et al., filed April 22, 1993.

⁶ Ahuja '90, p. 241, last sentence in the first full paragraph.

- Ensor et al., "The Rapport Multimedia Conferencing System – Software Overview," Computer Workstation Conference, IEEE, pp. 52-58, 1992.
- Ahuja et al., "Coordination and Control of Multimedia Conferencing," IEEE Communication Magazine, 30(5): 38-42, May 1992.
- Ahuja et al., "Networking Requirements of the Rapport Multimedia Conferencing System," INFOCOM '88, IEEE, pp. 746-751, 1988.

C. Conclusion.

For at least the reasons discussed herein, the Requests for Reexamination are not relevant to the patentability of the claims of the current application.

ATTACHMENT 1(e)(ii)

Relevancy of the Requests for *Ex Parte* Reexamination of U.S. Patent No. 6,237,025

An anonymous third-party Requestor filed a first Request for Reexamination on February 1, 2008 and a Replacement Statement and Explanation in the Request for Reexamination (together, “the requests”) on February 25, 2008 requesting reexamination of U.S. Patent No. 6,237,025. Applicants are providing these Requests for the Examiner’s consideration.

Applicants respectfully submit that the requests and the references cited therein are not relevant at least for the following reasons:

A. The Requests fail to demonstrate where many of the claim limitations are taught by the cited references. For example, and at a minimum, the Requests have not shown where the Rapport references teach:

1. “displaying ...participant information from at least the directory” and “selecting ...one or more participants ...from among the displayed participant information,” as required by independent claims 1, 11, 23 and 33; and
2. “association ... between the information in the directory and the database,” such that “the association is dynamically changeable,” as required by independent claims 23 and 33.

B. The ‘025 patent was allowed over prior art that is far more relevant to the claims of the ‘025 patent than the references relied upon in the Requests for Reexamination.

A. The Requests fail to demonstrate where many of the claim limitations are taught by the cited references.

The Requests for Reexamination incorrectly characterize the relied upon references and fail to show where the references teach many of the claim limitations.

The Reexamination requests rely primarily on a combination of articles (referred herein as the “Rapport references”). These include: (i) Ahuja et al.: *The Rapport Multimedia Conferencing System*, 1988 (hereinafter “Ahuja ‘88”), (ii) Ahuja et al.: *A*

Comparison of Application Sharing Mechanisms in Real-Time Desktop Conferencing Systems, 1990 (hereinafter “Ahuja ‘90”), and (iii) Ensor et al.: *The Rapport Multimedia Communication System (Demonstration)*, May 1992 (hereinafter “Ensor”).

1. The Reexamination requests do not show where the Rapport references teach displaying participant information from a directory and selecting one or more participants from among the displayed participant information, as required by independent claims 1, 11, 23 and 33.

The Reexamination requests allege that the Rapport references teach displaying participant information from a directory and selecting one or more participants from among the displayed participant information, as required by independent claims 1, 11, 23 and 33.¹ Specifically, the Reexamination requests refer to Ensor, pp. 581-582, Ahuja ‘88, p. 4 and Ahuja ‘90, p. 240 and Figure 1 as teaching these limitations.²

Ahuja’s Figure 1 shows seven face icon images and one blank rectangle. But, these icons are not part of a list that can be selected to establish a call. They represent actual participants already on a call. This is evident when Ahuja ‘90 states that “three of the eight conferees are using their telepointers to note items on the white board.”³ The “eight conferees” are the seven icons plus a blank, “iconless” rectangle at left. Thus, the seven icons represent conferees, not a list of participants that can be selected to be called. Further, Ahuja ‘88 supports this, “For example, we are now displaying a picture of each conferee...”⁴

Further Ahuja ‘92 specifically states that “when a person decides to interact with a second, he/she must be able to name the second.”⁵ Thus, rather than selecting from a displayed participant information, the user must input a name of a person to initiate a conference the named person.

¹ Replacement Statement and Explanation of U.S. Patent No. 6,237,025, filed February 25, 2008, p. 13, lines 1-8.

² Replacement Statement and Explanation of U.S. Patent No. 6,237,025, filed February 25, 2008, p. 13, lines 7-8.

³ Ahuja ‘88, p. 241, first full paragraph.

⁴ Ahuja ‘88, p.6, paragraph 1, line 4.

⁵ Ahuja ‘92, p. 41, col. 2, paragraph 2.

Additionally, Ensor specifically states that in order to initiate a conference, a telephone number must be dialed or name must be specified.⁶

Thus, none of the references even hint of displaying a list or icons or pictures of any kind that are selectable for initiating communications. The Rapport system has no need to display such information because communication is initiated by using call control operations “based on those of a conventional telephone accessed from the screen-based telephone.”⁷

Accordingly, the Reexamination requests’ assertions that the references teach this claim limitation of independent claims 1, 11, 23 and 33 are entirely incorrect.

2. The Reexamination requests do not show where the Rapport references teach “association ... between the information in the directory and the database,” such that “the association is dynamically changeable,” as required by independent claims 23 and 33.

The Reexamination requests allege that Figure 1 of Ahuja ‘90 also shows the claimed “dynamically changeable association” limitation recited in claims 23 and 33. The requests make the unsupported statement that the association is dynamically changeable. But, the requests never point to any place where these limitations are taught, stating only that the “[A]n association is implied, as to be able to specify a name, the directory and database must be associated.”⁸

Even if the Rapport system maintains a database where a name is associated with an address, it is unlikely that the Rapport references have any “dynamically changeable” association between information in a directory and a database. In contrast, the Rapport system teaches a fixed/static association between user and device. This is because the Rapport system is based on the telephone, where there is a fixed association. See “Rapport’s call control operations, based on those of a conventional telephone, are accessed from the screen-based telephone.”⁹ Ensor reinforces this when it states: “Rapport uses the telephone as the primary

⁶ Ensor, p. 581, col. 1, paragraph 2.

⁷ Ahuja ‘90, p. 241, section 3.

⁸ Replacement Statement and Explanation of U.S. Patent No. 6,237,025, filed February 25, 2008, Appendix I, p. xxiv, col. 2, lines 10-12.

⁹ Ahuja ‘90, p. 241, first full paragraph, lines 5 to 6.

framework for conducting meetings...Meetings are initiated by dialing a person's telephone number of specifying the name of the person to be called."¹⁰

Further, the Rapport system teaches a fixed/static association between user and device because there is no user tracking in Rapport.

Thus none of the Rapport references even hint of a dynamically changeable association between information is the directory and the database.

Accordingly, the Reexamination requests' assertions that the references teach this claim limitation of independent claims 23 and 33 are entirely incorrect.

B. The '025 patent was allowed over the Rapport related prior art that is far more relevant to the claims of the '025 patent than the Rapport references.

The '025 patent was issued over far more relevant prior art. Amongst this prior art are the following references, including many that give far greater detail on the Rapport system, and were cited in an IDS filed on January 13, 2000, and considered by the Examiner on June 2, 2000:

- U.S. Patent No. 5,471,318, issued November 1995 to Ahuja et al., filed April 22, 1993.
- U.S. Patent No. 5,689,553 November 1997, issued to Ahuja et al., filed April 22, 1993.
- Ensor et al., "The Rapport Multimedia Conferencing System – Software Overview," Computer Workstation Conference, IEEE, pp. 52-58, 1992.
- Ahuja et al., "Coordination and Control of Multimedia Conferencing," IEEE Communication Magazine, 30(5): 38-42, May 1992.
- Ahuja et al., "Networking Requirements of the Rapport Multimedia Conferencing System," INFOCOM '88, IEEE, pp. 746-751, 1988.

C. Conclusion.

For at least the reasons discussed herein, the requests for Reexamination of U.S. Patent No. 6,237,025 are not relevant to the patentability of the claims of the current application.

¹⁰ Ensor, p.501, col. 1, second paragraph, lines 1-8.

ATTACHMENT 1(e)(iii)

Relevancy of the Requests for Ex Parte Reexamination of U.S. Patent No. 5,758,079

An anonymous third-party Requestor filed a first Request for Reexamination on February 4, 2008 and a Replacement Statement and Explanation (together, “the requests”) on March 3, 2008 requesting reexamination of U.S. Patent No. 5,758,079. Applicants are providing these Requests for the Examiner’s consideration.

Applicants respectfully submit that the requests for reexamination and the references cited therein are not relevant at least because the Requests fail to demonstrate where at least one of the claim limitations is taught by the cited references. For example, and at least at a minimum, the Reexamination requests do not show where the Rapport references teach “notifying the first participant of the identity of each calling participant,” as required by independent claims 1 and 22.

The Reexamination requests rely primarily on a combination of articles (referred herein as the “Rapport references”). These include: (i) Ahuja et al.: *The Rapport Multimedia Conferencing System*, 1988 (hereinafter “Ahuja ‘88”), (ii) Ahuja et al.: *A Comparison of Application Sharing Mechanisms in Real-Time Desktop Conferencing Systems*, 1990 (hereinafter “Ahuja ‘90”), and (iii) Ensor et al.: *The Rapport Multimedia Communication System (Demonstration)*, May 1992 (hereinafter “Ensor”).

The Reexamination requests allege that the Rapport references teach “notifying the first participant of the identity of each calling participant,” as required by independent claims 1 and 22.¹ Specifically, the Reexamination requests refer to Ensor, p. 581, Ahuja ‘88, p. 1 and Ahuja ‘90, pp. 240, 241 and Figure 1 as teaching these limitations.²

Ahuja’s Figure 1 illustrates a screen-based telephone display that notifies a user that there is an incoming call, and provides three options to the user to respond to the incoming call: pick up, hang up or hold. However, there is no indication that the identity of the caller is identified to the user. There is a phone number “202-919-9273” at the bottom of the screen-

¹ Replacement Statement and Explanation of U.S. Patent No. 5,758,079, filed March 3, 2008, p. 12, lines 6-9.

² Replacement Statement and Explanation of U.S. Patent No. 5,758,079, filed March 3, 2008, p. 12, lines 10-8.

based telephone display; however, this very well could be the phone number of the user himself, and not the phone number of caller. Indeed, there is no indication whatsoever in the Rapport references that the phone number or other information identifying the caller is disclosed to the person being called.

Accordingly, the Reexamination requests' assertions that the references teach this claim limitation of independent claims 1 and 22 are entirely incorrect.

B. Conclusion.

For at least the reasons discussed herein, the requests for Reexamination of U.S. Patent No. 5,758,079 are not relevant to the patentability of the claims of the current application.